

Application Serial Number 10/533,515
Response to Office Action
Dated November 13, 2006

REMARKS / DISCUSSION OF ISSUES

Claims 1 and 10 are pending in the application. Claims 1, 6 and 10 are in independent form. Claims 2-4 and 7-8 are not rejected based on art.

Applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s).

The Examiner is respectfully requested to state whether the drawings are acceptable.

Rejections under 35 U.S.C. § 101

Claims 1-4 and 6-8 were rejected under 35 U.S.C. § 101 for allegedly lacking patentable utility. Applicants respectfully submit that this rejection is improper and should be withdrawn.

The Examiner asserts:

"The claimed invention is directed to 'detecting point correspondences' and 'finding possible matching pairs' which in and of itself does not constitute a specific and substantial utility."

The Examiner also turns to recent CAFC case law (without citation) for a practical test for determining statutory subject matter under Section 101 of the Code. The Examiner asserts, inter alia, that the test requires that a 'useful, concrete, and tangible result' be accomplished. However, the Examiner concedes that an abstract idea, when practically applied is eligible for a patent. Moreover, the Examiner asserts "...that there is no showing in the claims that the claims are for 'practical application' and what, if any, the final result is used for" [sic]. Finally, the Examiner asserts that the utility requirement must be satisfied.

Applicants turn attention to the USPTO Official Gazette Notice dated 22

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November 2005, "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" ("the OG Notice").

Even though the OG Notice merely contains guidelines for patent examiners, and does not have the full force and effect of law (see the OG Notice, Section I, second paragraph), the undersigned attorney has reviewed the guidelines and respectfully submits that the rejections of claims 1-4 and 6-8 are not compliant with these guidelines.

At the outset, Section IV of the OG Notice explains in detail the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. The only references to "tangible results" in this procedure appear under Step IV(C) – "*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*" Not surprisingly, the first thing the Examiner must do under Step IV(C) is to "*determine whether [a claim] covers either a Sec. 101 judicial exception or a practical application of a Sec. 101 judicial exception.*" Only ***IF*** such a determination is made, does the analysis ***then*** proceed to determine if the claimed subject matter is nevertheless still patentable subject matter, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

Here, the Office Action does not ever attempt to determine whether any or all of claims 1-4 and 6-8 cover either a Sec. 101 judicial exception (Law of Nature, Natural Phenomenon, or Abstract Idea) or a practical application of a Sec. 101 judicial exception. Rather, the Office Action relegates the rejected claims as not constituting a specific and substantial utility. Clearly this does not fall within the judicial exceptions to Section 101.

Applicant respectfully submits that none of the claims 1-4 and 6-8 cover

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any law of nature, natural phenomenon, or abstract idea. Claims 1-4 and 6-8 are drawn to methods and devices, respectively that are useful in finding matching pairs. These methods and devices do not cover any law of nature, natural phenomenon, or abstract idea. Accordingly, the entire analysis as to whether the claims "*produce a tangible result or a practical application*" is not even pertinent under the OG Notice, because the claims are not even directed to any Sec. 101 judicial exception in the first place.

For at least the reasons set forth above, Applicants respectfully submit that claims 1-4 and 6-8 are statutory subject matter and therefore the present rejection is improper and should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1, 5, 6, 9 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Ferris, et al.* (U.S. Patent 5,631,972). For at least the reasons set forth above, Applicants respectfully submit that this rejection is improper and should be withdrawn. Notably, claims 2-4 and 7-8 were not rejected based on art, and thus are believed to be drawn to patentable subject matter at least for the reasons set forth above.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed

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invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 is drawn to a method of detecting point correspondences, and includes:

- finding of possible matching pairs comprising a point from the first set of points and a point from the second set of points, and*
- finding a maximum number of matching pairs.*

The Office Action asserts that the reference to *Ferris, et al.* discloses finding a maximum number of matching pairs at column 8, lines 50-60 and column 10, lines 8-16 and 40-62. Applicants' attorney has reviewed the noted portions of the reference and has found not description of finding a maximum number of matching pairs. To wit, lines 50-60 of column 8 describe a flow of operation of a matcher once tables are available for search and file (finger)prints. Lines 8-16 of column 10 describe a set of steps and four-tuples that have survived in table 28; and the needed information to construct hyperladders. Lines 40-62 of column 10 describe the construction of hyperladders and search and file minutia.

However, there is no description of a method including finding a maximum number of matching pairs as specifically claimed. Additionally, it is respectfully submitted that the rejection does not clearly articulate how the portions of the applied art discloses such a feature. As such, Applicants submit that at least one feature of claim 1 is not disclosed in the applied art; and that a clearly articulated rejection in compliance with MPEP § 706 has been provided.

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Accordingly, Applicants respectfully submit that because at least one feature of claim 1 is not disclosed in the applied art, a *prima facie* case of anticipation has not been established. Therefore, claim 1 and the claims that depend therefrom are patentable over the applied art.

Claims 6 and 10, which are drawn to a device and a computer program, respectively, include a feature similar to the feature of claim 1 described above. Therefore, Applicants submit that because at least one feature of claims 6 and 10 is not disclosed in the applied art, a *prima facie* case of anticipation has not been established. As such, claims 6 and 10 and the claims that depend therefrom are patentable over the applied art.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted on behalf of:

NXP Incorporated



by: William S. Francos (Reg. No. 38,456)

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Volentinc Francos & Whitt, PLLC
Two Meridian Blvd.
Wyomissing, PA 19610
(610) 375-3513 (v)
(610) 375-3277 (f)